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10/767,191	01/30/2004	Anthony Bruce	APRE0003	5717

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EXAMINER	
ANDERSON, FOLASHADE	
ART UNIT	PAPER NUMBER
3623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,191	BRUCE ET AL.	
	Examiner	Art Unit	
	FOLASHADE ANDERSON	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 August 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) *1-23 and 40-42* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on ___ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This non-final office action is in response to Applicant's submission filed on August 24, 2009.

Claim Status

2. Currently, claims 1-42 are pending. Claims 1-23 and 40-42 are withdrawn from consideration. Claims 26 and 33-39 are amended.

Response to Amendment

3. Applicant's amendments to figure 1 is sufficient to overcome the drawing objection set forth in the previous office action.

4. Applicant's amendments to claims 26 and 38 are sufficient to overcome the claims objection set forth in the previous office action.

5. Applicant's amendment to claim 33 are sufficient to overcome the 35 USC § 101 rejection set forth in the previous office action.

Response to Arguments

6. Applicant's arguments filed with respect to the 35 USC § 103 have been fully considered but they are not persuasive. Applicant argues with respect to claims 24 and 33:

a. Harhen fails to teach measuring a business initiative using test sites and non-test sites, remarks p. 16

b. Harhen fails to teach analyzing or developing predictions based on business test, remarks p. 16

c. Harhen does not teach generating a ranked list of attributes on the attributes impact on performance values associated with test sites, remarks p. 17

d. Harhen cannot forecast the results for each non-test locations, remarks p. 17.

e. Harhen does relate to generating models based on how test locations performed relative to control locations during a test, remarks p. 17

In response to Applicant's arguments (6.a.), the recitation "measuring a business initiative using test sites and non-test sites" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to Applicant's arguments (6.b.) respectfully the Examiner disagrees with Applicant's accretion, and points out that with respect to the argument that references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "analyzing or developing predictions based on business test obvious ") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claimed limitation recites "instructing the server to execute the model for the test sites," Harhen teaches "information concerning an enterprise and its surrounding environment is modeled . . . allowing planning managers to accurately model factors which affect the enterprise" (col.8, lines 59-68) and "using the modeling system . . . user can specify a chain of interdependencies that accurately represent the environment of any enterprise" (col. 14, lines 39-46). The teachings of Harhen render the claimed limitation of analyzing or developing predictions based on business test obvious.

In response to Applicant's argument (6.c.) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "generating a ranked list of attributes. . . ") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim is only directed towards "receiving, from a server, a list of the attributes . . . associated with the test site." Harhen teaches the claimed limitation in at least the recitations of "the present invention provides for a categorization hierarchy of objects . . . the underlying representational medium, as well as the power of decomposition allows for very efficient model building," (col. 5, lines 3-14), "the attribute declarations specify a list of attributes or data slots that an object can contain," (col. 17, lines 16-21) and "the processor interfaces with each device and in gathering and outputting data through a plurality of input/output modules" (col. 8, lines 24-26). It would had been obvious to one of ordinary skill in the art that if the system of

Harhen gathered and output information and contained the list of attributes that these list were not only received as claimed but also generated as Applicant argues.

In response to Applicant's arguments (6.d.) respectfully the Examiner submits that Harhen was not used to teach this limitation see previous office action at page 6.

In response to Applicant's argument (6.e.) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "generating models based on how test locations performed relative to control locations during a test") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim limitation recites "receiving results of the executed model, wherein the results include quantitative measures of the model's ability to accurately predict the performance levels of the test sites." Harhen teaches this feature in at least "modeling, allows planning managers to accurately model the factors which affect the enterprise" (col. 8, lines 63-65) and "the modeling approach . . . creates ratio objects and their corresponding relationships where a proportionality relationship is specified between two other variables." (col. 21, lines 44-50).

7. Applicant's arguments with respect the prior art of Honarvar have been considered but are moot in view of the new ground(s) of rejection.

8. It is noted that the applicant did not challenge the officially cited facts in the previous office action(s) therefore those statements as presented are herein after prior art. Specifically it has been established that it was old and well known in the art at the

time of the invention to allow a user to remote access to a system for operating purposes (see claim 35).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 33 recites "a computer program product comprising . . . the method comprising." It is unclear whether the user is claiming the statutory class of a product or a method. For purposes of examination it is assumed that Applicant intends to claim a method. Claims 34-39 are also rejected based on the same rational, because they depend from claim 33 and therefore suffer the same deficiencies.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 24-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harhen (US Patent 5,406,477) in view of Pednault et al (US Patent 7,451,065 B2).

Claims 24 and 33

Harhen teaches a method for analyzing a business initiative for a business network including business locations including test sites that have implemented the business

initiative during a predetermined test period and non-test group sites that have not implemented the initiative, each of the sites being associated with a set of attributes, the method comprising:

- receiving, from a server, a list of the attributes ranked based on each attribute's impact on performance values associated with the test sites during the test period (**Harhen col. 5, lines 4-7 and col. 8, lines 17-20)**;
- configuring a model to predict the performance value of the sites based on the ranked list of attributes **(Harhen col. 8, lines 63-68)**;
- instructing the server to execute the model for the test sites **(Harhen col. 14, lines 59-68)**
- receiving results of the executed model, wherein the results include quantitative measures of the model's ability to accurately predict the performance levels of the test sites (**Harhen col. 41, lines 15-20)**;

Harhen does not expressly teach:

- instructing the server to apply the model to the non-test group sites to predict the performance levels of the non-test group sites based on a determination that the model accurately predicts the performance levels of the test sites; and
- receiving a list of non-test group sites ranked based on each non-test group site's predicted performance level.

Pednault teaches

- instructing the server to apply the model to the non-test group sites to predict the performance levels of the non-test group sites based on a determination that the

model accurately predicts the performance levels of the test sites (**Pednault col. 8, lines 7-14 and 57-62)**; and

- receiving a list of non-test group sites ranked based on each non-test group site's predicted performance level (**Pednault col. 73, lines 1-6)**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen the control group features as taught by Pednault since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 33 which is the system for implementing the method of claim 24 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 25 and 34

Harhen and Pednault teach all the features of claim 24 and Honarvar further teaches selecting a subset of the non-test group sites to implement the business initiative based on the ranked list of those sites (**Pednault col. 73, lines 1-6)**.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen the control group features as taught by Pednault since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did

separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 34 which is the system for implementing the method of claim 25 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 26

Harhen and Pednault teach all the features of claim 24 and Harhen further teaches selecting the model from a list of models provided by the server; and selecting one or more parameters for the selected model **(Harhen col. 20, line 24 and col. 37, lines 7-15)**;

Claim 27 and 39

Harhen and Pednault teach all the features of claim 24 and Harhen further teaches reconfiguring the model with at least one new parameter based on a determination that the model does not accurately predict the performance levels of the test sites **(Harhen col. 18, lines 40-43)**; and instructing the server to execute the reconfigured model for the test sites. **(Harhen col. 6, lines 44-63).**

With respect to claim 39 which is the system for implementing the method of claim 27 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 28 and 38

Harhen and Pednault teach all the features of claim 27 and Harhen further teaches repeating the reconfiguring and executing the reconfigured model until the quantitative measure reflect that the model accurately predicts the performance levels of the test sites **(Harhen col. 6, lines 44-63)**.

With respect to claim 38 which is the system for implementing the method of claim 28 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 29 and 37.

Harhen and Pednault teach all the features of claim 24 and Harhen further teaches selecting a number of the ranked attributes that the model should consider when executing (**Harhen col. 5, lines 4-7 and col. 8, lines 17-20)**.

With respect to claim 37 which is the system for implementing the method of claim 29 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 30.

Harhen and Pednault teach all the features of claim 24 and Harhen further teaches wherein the quantitative measures includes a ranked list of selected attributes that the model considered during its execution and data values assigned to each of the selected attributes by the model **(Harhen col. 17, lines 23-27)**.

Claim 31.

Harhen and Pednault teach all the features of claim 30 and Harhen further teaches, wherein the data values includes a coefficient data value for a mathematical function used by the model to generate the results **(Harhen col. 17, lines 5-15)**.

Claim 32 and 36

Harhen and Pednault teach all the features of claim 24 and Harhen further teaches wherein the list of the attributes ranked based on each attribute's impact on the test site **(Harhen col. 17, lines 23-27)**.

Harhen does not teach; however, Pednault does teach, wherein the non-test group sites includes a set of control group sites and performance values is generated by the server based on comparisons between test site fragments and corresponding control group site fragments, wherein each fragment is generated by the server based on each respective site's attribute value and performance value (**Pednault col. 51, lines 10-25)**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen the control group features as taught by Pednault since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

With respect to claim 36 which is the system for implementing the method of claim 32 and is essentially the same as the method it is rejected for the same reasoning given above.

Claim 35

Harhen and Pednault teach all the features of claim 34 however neither teaches where in the user operates a client remotely located from the system.

Official notice is taken that it was old and well known in the art at the time the invention was made to allow a user to remote access to a system for operating purposes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Harhen and Pednault the very old and well known feature of in the user operates a client remotely located from the system since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Opdycke (US 2005/0039206 A1) teaches independent attributes to find statistical significance and relevance of marketing objectives with respect to various goals. Louviere et al (US 6,934,748 B1) teaches experimentation to measure users behavior. Frye et al (US 2001/0032105 A1) teaches a method for introducing a new project into a business. Schumann (US 2004/0153360 A1) teaches .

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is

(571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623